

Remarks

Claims 1-17 are pending in this application. Claims 16-17 are newly added.

The indication of allowable subject matter in claims 8 and 11-14 is noted with appreciation. Claim 16 is derived by incorporating the subject matter of claims 1 and 12. Claim 17 is a variation of claim 9 drafted to further distinguish from the asserted prior art of record. By so amending, newly added claims 16-17 are believed to be in condition for allowance.

At the outset before analyzing each of cited documents individually and specifically with the present invention, the important points of the present invention need to be emphasized:

1) The maze pathway is completely invisible and no part of which needs to be made visible to play the Cube maze game successfully;

2) The maze game has one entry hole, one exit and several escape holes to bring the ball to a start position quickly and easily when the ball is lost inside a blind pathway;

3) The maze pathways are all straight lines without any curves;

4) one of the most significant parts of the pathway are the 6-way intersections, where 3 pathways cross each other at right angles and where the ball travels along a vertical pathway and

comes to rest just after the crossing at a conical end such that the ball will stay there until the Cube is tilted by 90 degrees to bring one of the horizontal pathways to a vertical position allowing the ball to drop down at the end of that pathway. Of the 4 horizontal pathways only one will lead to the next 6-way intersection to continue along the correct path or to the exit hole and the other three will lead to blind lanes which will not lead to the exit hole no matter how many 90 degree turns are made. (Basis of which is found at page 8, lines 5-20 of the written specification);

5) When the ball is lost inside blind lanes, which are not visible, in order to make the toy user friendly, there are several escape holes strategically placed that terminates on the top surface where the entry hole is and the ball can be brought to said top surface simply by shaking the cubes sideways in all directions keeping the start surface down. (Basis of which is found at page 9, lines 5-10 of the written specification); and

6) Also the pathway is so designed that difficulty level in solving the game can be changed from being very easy suitable for a 6 yr. old kid to being very difficult simply by placing some plugs in strategic positions in the pathway. So far with same moulded items for the track-bodies it has been possible to produce 10 difficulty levels of the game. (Basis of which is found at page 10, lines 3-6 of the written specification).

It is submitted that the present invention resides in a maze game where the user / player has to bring out the object through an exit point by following a fixed number of steps in turning the maze and finding out the correct sequence of turns and requires considerable amount of mental dexterity. It is further submitted that the concept of the present invention lies in providing a varying complexity of the game by a selection of a number of blind pathways by way of which substantial mental dexterity is required as the object will be lost in a blind pathway if the object is not turned in the correct sequence and the game has to be restarted all over again and to retrieve the object from any one of the multiple escape holes on the top surface by shaking the cube in all directions making the cube user friendly.

Studying the cited patents, it is noted that Reiner, Stafford and Wampler requires visual ability to observe part of the pathway in order to proceed along a correct route. These features are mentioned in:

Reiner: column 1 lines 59 to 66

Stafford: column 4 lines 47 to 54

Wampler: claims 4 & 5

None of the above three patents have any provisions for escape holes to restart the game if one is lost in blind lanes.

This means they are not user friendly and probably not marketable.

The single/multiple exit apertures are already indicated in claim 1 of the present invention and also indicated in point no. 5 above from which it is clear that the ball can escape out from the escape holes simply by shaking the cubes sideways in all directions keeping the start surface down and this type of feature is not directed in any of the cited documents which well distinguishes the present invention therefrom.

One very important point of the unique pathway with 6-way intersection is that after the ball comes to rest at the conical end (by the way it need not be conical so long as the ball is held in a position close to the intersection so that it will drop down a vertical path when the Cube is turned by 90 degrees) of the vertically traveled pathway just after crossing the 6-way intersection, it (the ball) CANNOT GO BACK TO IT'S ORIGINAL POSITION, because to do so the Cube have to turn by 180 degrees but midway when the Cube is turned by right angle it will drop in the pathway that is vertical.

In all the Patent Documents cited by the Examiner, the ball can travel back and forth in any segment of the pathway from one end to another.

In the present invention, the pathways are simple & straight and parallel to the Cube sides so that when the Cube rests on one

of it's face one pathway of the 6-way intersection becomes vertical and 4 other pathways meeting at the intersection are horizontal. Thus without being able to see the pathway the player can follow a pathway by just turning the Cube by 90 degree steps.

Referring to reference US2509340, it teaches tortuous pathways and false passages through which the ball is adapted to pass. There is no interconnection of pathways as those shown in the present invention. The direction of US2509340 is totally different thus cannot be compared to the present invention.

It is further submitted that for the foregoing reasons, it will not be possible for a person of ordinary skilled in the art to reach a puzzle/maze game with varying complexities for solution as described in the present invention.

#### **Priority**

It is stated that acknowledgment is made of applicant's claim for foreign priority based on an application filed in India. It is noted that applicant has not filed a certified copy of the 621/CAL/02 application as required by 35 U.S.C. 119(b).

Please note that this application is a national phase of a PCT application. All relevant documents, including the certified copy of the priority document should have been communication by the International Bureau to the U.S. Patent & Trademark Office. Therefore, a certified copy of priority document is not

redundantly submitted herewith. However, if it is determined that the International Bureau has failed to provide a certified copy of priority document, the Applicant will be happy to furnish a certified copy of priority document upon request.

**Claim Rejections - 35 USC 103**

Claims 1-4, 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wampler (U.S. Patent No. 4,494,753) in view of Stafford (U.S. Patent No. 3,787,054). This rejection is traversed for reasons stated hereinbelow.

In the outstanding Office action, the Office has specifically stated that "Wampler does not show a non-transparent body.

To overcome this shortcoming of Wampler, the Office further stated that:

"it would have been obvious to do so in view of Stafford who teaches that transparent, partially transparent and non-transparent mazes are all well known in the art and it would have been obvious to one of ordinary skill in the art to use a particular embodiment for a specific difficulty of the game."  
[Emphasis added]

Column 1, lines 14-25 of Wampler has specifically stated that:

"An object of this invention is to provide a rather complicated visual aid and competitive toy to teach users the cooperative effects of gravity and spatial position about a three-dimensional axis system.... And still another object of this invention

is to provide a safe and convenient means of improving hand-eye coordination in young and old persons alike."

Therefore, it is the very objectives of Wampler to provide a complicated visual aid and competitive toy and to improve hand-eye coordination in young and old persons alike. To make Wampler non-transparent as suggested by the Office would eliminate the very visual aid objective and hand-eye coordination objective of Wampler.

MPEP 2143.01 has specifically stated that:

"[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Since making the embodiment of Wampler non-transparent would render the Wampler invention being so modified unsatisfactory for its intended purpose, then it is both the position of the United States Patent & Trademark Office and the Federal Circuit that there is no suggestion or motivation to make the Office proposed modification.

Section 706.01(j) of the MPEP has specifically stated that:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or

suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991)"

It is respectfully submitted that the Office has not established a prima facie case of obviousness, because, 1) there is no motivational statement or incentive to make Wampler non-transparent, because the very objectives of visual aid and hand-eye coordination require transparency; 2) there would not be any reasonable expectation of success to achieve the objectives of visual aid and hand-eye coordination should the embodiment of Wampler be made non-transparent.

For the foregoing differences, independent claim 1 is patentably distinguished over Wampler in view of Stafford, all claims dependent thereon, including claims 2-15, by virtue of inherency, are also patentably distinguished over Wampler and Stafford further in view of whatever other secondary reference.

Since a prima facie case of obviousness has not been established in this Office action, it would be improper for the Office to provide a new ground of rejection and make the next Office action final, because it would effectively preclude the applicant an opportunity to respond to the new ground of rejection.

Claims 5 and 7 were rejected under 35 U.S.C. 103(a) as being



unpatentable over Wampler and Stafford as applied above further in view of Fly (U.S. Patent No. 2,509,340). This rejection is traversed for reasons stated hereinbelow.

As mentioned above, independent claim 1 is patentably distinguished over Wampler in view of Stafford, all claims dependent thereon, including claims 2-15, by virtue of inherency, are also patentably distinguished over Wampler and Stafford further in view of whatever other secondary reference.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wampler and Stafford as applied above in view of Reiner et al. (U.S. Patent No. 4,008,895). This rejection is traversed for reasons stated hereinbelow.

As mentioned above, independent claim 1 is patentably distinguished over Wampler in view of Stafford, all claims dependent thereon, including claims 2-15, by virtue of inherency, are also patentably distinguished over Wampler and Stafford further in view of whatever other secondary reference.

Reconsideration and withdrawal of this rejection are respectfully requested.

Allowable Subject Matter

Claims 8 and 11-14 were objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In reliance upon the Office indicated allowable subject matter, a new claim 16 derived by incorporating the subject matter of claims 1 and 12 is added herein by amendment.

New claim 17 is also added herein by amendment as a slight variation of claim 9 to further define the present invention.

Entry and allowance of newly added claims 16-17 are respectfully requested.

CONCLUSION

The present invention is believed to be in condition for allowance. The Examiner is requested to contact the Undersigned Attorney if a Notice of Allowance will not be issued to this case.

The Commissioner is hereby authorized to charge any underpayment of fees or credit any overpayment of fees in connection with this communication to Deposit Account Number 502840.

Respectfully submitted,  
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